

REMARKS

By this amendment, claims 1-2, 4-14, and 18-24 have been amended, and claims 25-26 have been added. The specification has been amended to correct certain informalities. Accordingly, claims 1-2, 4-14, and 18-26 are currently pending in the application, of which claims 1, 8, 11 and 18 are independent claims.

Applicant respectfully submits that the above amendments do not add new matter to the application and are fully supported by the specification. Support for the amendments and added claims may be found at least in Figures 1-4 and at page 10, line 3 through page 19, line 8, and at page 19, lines 15-22 of the specification.

In view of the above amendments and the following Remarks, Applicant respectfully requests reconsideration and timely withdrawal of the pending objections and rejections for the reasons discussed below.

Rejections Under 35 U.S.C. § 103

Claims 1-2, 4, 6, 8-14, and 18-24 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application Publication No. 2002/0111167 filed by Nguyen, *et al.* ("Nguyen") in view of U.S. Patent No. 6,493,431 issued to Troen-Krasnow, *et al.* ("Troen-Krasnow").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the reference or references, when combined, must disclose or suggest all of the claim limitations. The motivation to modify the prior art and the reasonable expectation of success must both be found in the prior art and not based upon a patent applicant's disclosure. *See in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

“Motivation to modify the references”

The cited references fail to establish a prima facie case of obviousness because, *inter alia*, the examiner has asserted an insufficient motive to modify the references.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Further, the “references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.” See MPEP, Chapter 2141. Rather, “the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” See MPEP, Chapter 2142.

Here, the examiner has asserted an insufficient motivation for combining the references by relying strictly on hindsight and the advantages offered by the present invention. The Office Action fails to cogently describe how the references “expressly or impliedly suggest the claimed invention.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Rather, the Office Action, on page 4, summarily concludes that it would have been obvious to combine Nguyen and Troen-Krasnow to “allow[] the called party to receive and retrieve notifications and messages while logged on to a personal computer.” Absent this impermissible hindsight, the examiner provides no legal conclusion “reached on the basis of the facts gleaned from the prior art.”

Moreover, “[i]n order to rely on a reference as a basis for [an obviousness-based] rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” MPEP, Chapter 2141.01(a) (citing to In re Oetiker, 977 F.2d 1443,

1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). Here, Troen-Krasnow is neither in the field of Applicant's endeavor nor reasonably pertinent to the problem faced by Applicant.

In the Office Action, the examiner fails to show why a person of ordinary skill in the art at the time of Applicant's invention ("POSITA"), and faced with the disclosure of Nguyen, would have looked to the disclosure of Troen-Krasnow. Troen-Krasnow is directed to a voice-mail system that permits a user, generally a business, to receive messages left by callers only when "all telephone lines are busy or a call is not answered." See Troen-Krasnow, col. 1, lines 42-43; col. 2, lines 30-31. Conversely, the present invention is provided, for example, for "alarming an incoming message" to "[o]ffice workers who conduct their business on their personal computers (PCs) [and] generally set their mobile communication terminals to a vibration mode or lamp mode for a call or a short message." See specification, page 1, line 14; page 2, lines 1-4. Since Troen-Krasnow is directed neither towards mobile communication terminals nor to "alarming an incoming message," it is not pertinent to field of Applicant's endeavor nor to the problem faced by Applicant. Therefore, a POSITA at the time of Applicant's invention would not have been motivated to modify Nguyen's disclosure with the teachings of Troen-Krasnow.

Thus, because the examiner does not provide a "convincing line of reasoning" to suggest the combination of the cited references, and because a POSITA at the time of Applicant's invention would not have been motivated to modify Nguyen's disclosure with the teachings of Troen-Krasnow, the examiner's purported motivation cannot survive.

"All the Claim Limitations"

Further, assuming *arguendo* that the references may be combined and a reasonable expectation of success exists, the combined references do not disclose or suggest all of the claim limitations.

Specifically, Applicant respectfully submits that the cited references fail to disclose or suggest all claim limitations of claim 1. Claim 1 as amended recites, *inter alia*,

a messenger service system ...for sending a second notification message to a personal computer, the second notification message for providing real-time notification of the incoming message.

Nguyen, either alone or in combination with Troen-Krasnow, fails to disclose at least these features. The examiner concurs that Nguyen fails to disclose “sending incoming message alarming information indicating arrival of the incoming message to a personal computer,” and looks to Troen-Krasnow to teach these features. See Office Action, page 3.

However, Troen-Krasnow fails to remedy the shortcomings of Nguyen. As described in Troen-Krasnow, a message server “sends a notification to the called party that a call has been received.” See Troen-Krasnow, col. 5, lines 1-2. However, this notification is sent from the message server only after the called telephone is “busy or the calling party receives no answer.” See Troen-Krasnow, col. 4, line 18. Thus, Troen-Krasnow fails to disclose “a messenger service system ...for sending a second notification message to a personal computer, the second notification message for providing real-time notification of the incoming message” (emphasis added).

Similarly, Applicant respectfully submits that the cited references fail to disclose or suggest all claim limitations of claim 8. Claim 8 as amended recites, *inter alia*,

wherein the messenger service system sends a second notification message for providing real-time notification of the incoming message to a personal computer.

Nguyen, either alone or in combination with Troen-Krasnow, fails to disclose at least these features. The examiner concurs that Nguyen fails to disclose “the message service system sends incoming message alarming information indicating arrival of the incoming

message to a personal computer,” and looks to Troen-Krasnow to teach these features. See Office Action, page 7.

However, Troen-Krasnow fails to remedy the shortcomings of Nguyen. As described in Troen-Krasnow, a message server “sends a notification to the called party that a call has been received.” See Troen-Krasnow, col. 5, lines 1-2. However, this notification is sent from the message server only after the called telephone is “busy or the calling party receives no answer.” See Troen-Krasnow, col. 4, line 18. Thus, Troen-Krasnow fails to disclose “the messenger service system sends a second notification message for providing real-time notification of the incoming message to a personal computer” (emphasis added).

Applicant respectfully submits that the cited references also fail to disclose or suggest all claim limitations of claim 11. Claim 11 as amended recites, *inter alia*,

a messenger server for sending a second notification message to a personal computer corresponding to the IP address, wherein the second notification message provides real-time notification of an incoming message transmitted to a wireless communication system.

Nguyen, either alone or in combination with Troen-Krasnow, fails to disclose at least these features. The examiner concurs that Nguyen fails to disclose “sending incoming message alarming information indicating arrival of the incoming message to a personal computer,” and looks to Troen-Krasnow to teach these features. See Office Action, page 10.

However, Troen-Krasnow fails to remedy the shortcomings of Nguyen. As asserted above, Troen-Krasnow’s message server “sends a notification to the called party that a call has been received” only after the called telephone is “busy or the calling party receives no answer.” See Troen-Krasnow, col. 5, lines 1-2; col. 4, line 18. Thus, Troen-Krasnow fails to disclose “a messenger server for sending a second notification message to a personal computer ... wherein

the second notification message provides real-time notification of an incoming message" (emphasis added).

Applicant respectfully submits that the cited references fail to disclose or suggest all claim limitations of claim 18. Claim 18 as amended recites, *inter alia*,

providing real-time notification of the incoming message to a personal computer corresponding to the IP address.

Nguyen, either alone or in combination with Troen-Krasnow, fails to disclose at least these features. The examiner concurs that Nguyen fails to disclose the message service system alarming arrival of the incoming message to a personal computer, and looks to Troen-Krasnow to teach these features. See Office Action, page 12.

However, Troen-Krasnow fails to remedy the shortcomings of Nguyen. As asserted above, Troen-Krasnow's message server "sends a notification to the called party that a call has been received" only after the called telephone is "busy or the calling party receives no answer." See Troen-Krasnow, col. 5, lines 1-2; col. 4, line 18. Thus, Troen-Krasnow fails to disclose "providing real-time notification of the incoming message to a personal computer corresponding to the IP address" (emphasis added).

Since Troen-Krasnow fails to remedy the shortcomings of Nguyen with respect to claims 1, 8, 11 and 18, the combined references fail to disclose or suggest all features of these claims.

Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 8, 11 and 18. Claims 2, 4, 6, 9-14, and 19-24 depend from these independent claims and are allowable at least for this reason. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicant respectfully submits that independent claims 1, 8, 11 and 18, and all the claims that depend therefrom, are allowable.

Claims 5 and 7 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Nguyen in view of Troen-Krasnow, further in view of U.S. Patent Application Publication No. 2005/0097142, filed by Best, *et al.* ("Best").

Applicant respectfully submits that claim 1 is allowable over Nguyen in view of Troen-Krasnow, and Best fails to cure the deficiencies of Nguyen and Troen-Krasnow noted above with regard to claim 1. Hence, claims 5 and 7 are allowable at least because they depend from an allowable base claim 1.

Added Claims

Added claims 25 and 26 incorporate features previously embodied in claims 9 and 14, respectively, and therefore do not add new matter. Further, claim 25 depends from claim 8, and claim 26 depends from claim 11. For at least the reasons asserted above, claims 8 and 11 are allowable. Hence, claims 25 and 26 are allowable at least because they depend from allowable base claims.

CONCLUSION

Applicant believes that a full and complete response has been made to the pending Office Action and respectfully submits that all of the stated grounds for rejection have been overcome or rendered moot. Accordingly, Applicant respectfully submits that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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